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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 579

In the Matter of the Application of

FRIEDRICH GRUSCHWITZ AND
ALBERT FRITZ, *Petitioners,*

For Spray-Plastering-Device for Applying Mortar to Ceilings and Walls of Buildings

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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INDEX

	Page
Opinions below	1
Jurisdiction	2
Question presented	2
Statutes involved	2
Statement	3
Reasons for granting the writ	4
Conclusion	9
Appendix A—Opinions below	
Majority Opinion	1a
Concurring Opinion of Judge Martin	7a
Dissenting Opinion of Judge Rich	8a
Dissenting Opinion of Judge Smith	26a

TABLE OF AUTHORITIES CITED

CASES:	
Arnold and Brandt, Application of, 315 F. 2d 951	6
Conley v. *Gibson*, 355 U.S. 41	8
Dichter, In re, 110 F. 2d 664	6
Glidden Company v. *Zdanok*, 370 U.S. 530	7
Indianapolis v. *Chase National Bank-Trustee*, 314 U.S. 63	8
Le Page's Incorporated, Application of, 312 F. 2d 455	8
Timmerbeil, Application of, 320 F. 2d 413	5
STATUTES:	
28 U.S.C. § 1256	2
35 U.S.C.	
§ 142	2, 3, 4, 5, 6, 7, 8
§§ 141-144	3
Patent Act of 1839, § 11	5
MISCELLANEOUS:	
Annual Report of the Director of the Administrative Office of the United States Courts—1961 (1962)	7

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Petitioners pray that a writ of certiorari issue to review the judgment of the United States Court of Customs and Patent Appeals, entered in the above entitled case on July 26, 1963.

OPINIONS BELOW

The Patent Office Examiner's final rejection (R. 21-22), the Examiner's Answer (R. 31-32) to petitioner's brief on appeal in the Patent Office, and the

opinion of the Patent Office Board of Appeals (R. 32-45) are unreported and appear in the printed record. The majority opinion of the Court of Customs and Patent Appeals and the dissenting opinions of Judges Rich and Smith, printed in Appendix A hereto, are reported in 320 F. 2d 401.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on July 26, 1963. *Infra*, p. 7a. The jurisdiction of this Court is invoked under 28 U.S.C. § 1256.

QUESTION PRESENTED

Whether 35 U.S.C. § 142, which states that a party seeking to appeal an adverse determination of the Patent Office Board of Appeals to the United States Court of Customs and Patent Appeals must file in the Patent Office his reasons of appeal specifically set forth in writing, is to be narrowly construed so as to bar consideration on the merits of an appeal where the reasons of appeal are set forth in writing and, as a practical matter, do fully apprise the Commissioner of Patents and the Court of Customs and Patent Appeals of the points at issue.

STATUTES INVOLVED

28 U.S.C. § 1256, 62 Stat. 928. Court of Customs and Patent Appeals; certiorari.

> "Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari."

35 U.S.C. § 142, 66 Stat. 802. Notice of Appeal

> "When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner,

and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints."

STATEMENT

On December 22, 1960, the Patent Office Examiner filed a final rejection refusing to grant petitioners Gruschwitz and Fritz a patent covering their invention of a Spray Plastering-Device for Applying Mortar to Ceilings and Walls of Buildings. R. 21-22. The Examiner based his decision on a finding that a patent application had been filed in Germany more than one year prior to the date of filing in the United States and concluded that such filing constituted a statutory bar to the issuance of a patent. The Patent Office Board of Appeals affirmed the decision of the Examiner on August 1, 1961 (R. 32-45), and pursuant to 35 U.S.C. §§ 141-144, petitioner appealed to the Court of Customs and Patent Appeals on October 31, 1961.

In connection with appeals taken to the Court of Customs and Patent Appeals, Section 142 of 35 U.S.C. provides, in part:

> "... the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal specifically set forth in writing ...."

In the instant case, the petitioners filed a Notice of Appeals with the Commissioner of Patents (R. 46), setting forth the following reasons of appeal.

> "1. It was error to affirm the decision of the Examiner in his rejection of claims 10 to 16."
>
> "2. It was error to refuse to allow the rejected claims."

The Court of Customs and Patent Appeals dismissed the appeal, holding that the petitioners had failed to satisfy the requirement of Section 142 that the reasons of appeal be specifically set forth in writing. The opinion below was written by Chief Judge Worley and concurred in by Judge Jackson. Judge Martin, in a separate opinion, concurred in the result. Judge Martin stated that the reasons of appeal given by the petitioners in the instant case, while sufficient on another set of facts, were here insufficient because "... there are several dates involved, any one of which could be determinative of the issues here presented ..." *Infra*, p. 8a. In the opinion of Judge Martin, the petitioner's reasons of appeal were insufficient solely because they failed to set forth petitioner's position as to the Patent Office Board of Appeals' disposition of the various dates in question.

Judge Rich and Judge Smith dissented in separate opinions. In an extensive opinion, Judge Rich noted what he believed was an inconsistency between the instant case and several similar cases recently decided. He characterized the opinion of the majority as a retreat "... into the barren world of useless legal technicalities from which we [the court] were so hopefully emerging." *Infra*, p. 10a.

REASONS FOR GRANTING THE WRIT

The decision below involves an important question of federal law which has not been, but should be, settled by this Court because of its impact on the effective administration of justice by the Court of Customs and Patent Appeals and because of its impact on the scores of patent applicants who annually appeal adverse determinations of the Patent Office Board of

Appeals. In addition, the decision of the Court below is wrong and has so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

1. The requirement of Section 142 that reasons of appeal be specifically set forth in writing originated with Section 11 of the Patent Act of March 3, 1839 and has formed a part of the law since that date. This requirement has been given, in the words of Judge Rich, dissenting below, ". . . a bewilderingly inconsistent construction, sometimes fiercely literal and restrictive, sometimes inexplicably liberal, most of the time accepting the reasons presented to it without comment because their sufficiency was not challenged. *Infra*, p. 11a. In the language of Judge Smith, discussing this precise point, ". . . the often contradictory opinions of this court . . . present one of the most confused and perplexing situations imaginable." *In re Timmerbeil*, 320 F. 2d 413, 418.

The importance of the decision below is apparent from the narrow and overly technical view it takes of Section 142 and from its practical impact on the administration of justice. The interpretation given to this procedural provision by the court below is so constricted as to annually preclude consideration on the merits of cases of importance not only to the parties concerned, but also to all persons beneficially interested in the effective implementation of the patent laws.

The exhaustive dissenting opinion of Judge Rich in the instant case clearly points to the need for a final determination by this Court of the procedural point here at issue. The Appendix to Judge Rich's dissenting opinion (*Infra*, p. 23a) sets forth ninety-two cases

in which the Court of Customs and Patent Appeals has rendered a decision dealing with the requirements of Section 142 and clearly demonstrates that the question at issue has been, over an extended period of time, troublesome and time consuming to the Court of Customs and Patent Appeals and litigants alike.

A comparison of the instant case and one so recently decided as *In re Arnold and Brandt*, 315 F. 2d 951 (decided on April 25, 1963), clearly reveals the confusion engendered by the inconsistent decisions of the Court of Customs and Patent Appeals on this point. In *In re Arnold and Brandt*, *supra*, the reasons of appeal set forth by the appellant were as follows:

> "1. It was error to affirm the decision of the Examiner in his rejection of Claims 18 to 28.
>
> "2. It was error to refuse to allow the rejected claims." 315 F. 2d 951, 952."

The Court of Customs and Patent Appeals held that the above-quoted reasons of appeal complied with Section 142 noting, however, that its decision ". . . appears to be somewhat inconsistent with In re Dichter, 110 F. 2d 664, 27 CCPA 1060." *Ibid.* In the instant case, the Court of Customs and Patent Appeals, relying primarily on *In re Dichter*, 110 F. 2d 664, held that the following reasons of appeal fell short of the statutory standard set by Section 142:

> "1. It was error to affirm the decision of the Examiner in his rejection of claims 10 to 16.
>
> "2. It was error to refuse to allow the rejected claims."

From the above, it seems eminently clear that the patterns of decisions of the Court of Customs and

Patent Appeals, in fact, has led, in the words of Judge Rich ". . . to the utter bafflement of the bar, the dismay of the litigants, and the denigration of their attorney's professional reputation." *Infra*, p. 22a.

This Court's responsibility for the proper functioning of the federal judiciary extends to the Court of Customs and Patent Appeals. See *Glidden Company v. Zdanok*, 370 U.S. 530. This responsibility requires that a clear standard to be established to guide litigants in this area in lieu of the wavering and uncertain rule that currently prevails to the confusion of all parties concerned.

2. The decision of the court below involves an interpretation of Section 142 of 35 U.S.C., the statutory provision which governs all appeals taken by disappointed patent applicants to the Court of Customs and Patent Appeals. Any judicial interpretation of this provision is of critical importance to all persons bringing appeals to the Court of Customs and Patent Appeals from the Patent Office Board of Appeals.

For the fiscal year ending June 30, 1961, there were one hundred and forty-eight such appeals pending before the Court of Customs and Patent Appeals. *Annual Report of The Director of the Administrative Office of The United States Courts*—1961, p. 318 (1962). The decision of the Court below thus extends well beyond the petitioners in the instant case, and the rights and privileges of many unseen appellants may be affected if the rule of the majority is allowed to stand. Therefore, resolution of the question by this Court is in the public interest because of the significant number of appeals annually brought from the Patent Office Board of Appeals to the Court of Customs and Patent Appeals.

3. This Court's responsibility for the effective administration of justice within the federal judiciary requires that the archaic view of procedure espoused by the majority below be set aside.

The decision below seems clearly to clash with the wisdom of Mr. Justice Frankfurter's statement in *Indianapolis* v. *Chase National Bank, Trustee*, 314 U.S. 63, 69, that "Litigation is the pursuit of practical ends, not a game of chess." That litigants should not be denied their day in court for failure to satisfy procedural technicalities is today accepted as a jurisprudential precept. As Judge Rich said in discussing Section 142 in *In re LePage's Incorporated*, 312 F. 2d 455, 467, "The business of modern courts is to decide issues and settle disputes and not to make life unnecessarily difficult for litigants with no gain to itself."

The instant case, it is submitted, is one in which the Court of Customs and Patent Appeals has interpreted Section 142 in such a way as to ". . . make life unnecessarily difficult for litigants with no gain to itself." *In re LePage's Incorporated, supra.*

The petitioners, in their view of Section 142 align themselves with this Court which, in discussing the function of the Federal Rules of Civil Procedure, stated:

> "The Federal Rules reject the approach that pleading is a game of skill in which one misstep by counsel may be decisive to the outcome and accept the principle that the purpose of pleading is to facilitate a proper decision on the merits." *Conley* v. *Gibson*, 355 U.S. 41, 48.

It is the petitioner's belief that the decision of the court below is wrong and that the view of the role of

procedural rules implicit therein is archaic and outmoded and represents so significant a departure from the accepted and usual course of judicial proceedings as to call for the exercise by the Court of its power of supervision over the federal judiciary.

CONCLUSION

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

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UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

October Term 1962
Patent Appeal No. 6885
Serial No. 717,732

IN THE MATTER OF THE APPLICATION OF
FRIEDRICH GRÜSCHWITZ AND ALBERT FRITZ

July 26, 1963

WORLEY, *Chief Judge*.

All the claims, 10 through 16, in appellant's application[1] for a patent on a "Spray-Plastering-Device for Applying Mortar to Ceilings and Walls of Buildings" were rejected as unpatentable over the single reference, Fritz et al., German, Patent No. 1,013,861, January 23, 1958.

In affirming the examiner's rejection, the Board of Appeals states:[2]

> This is an appeal from the final rejection of all the claims in the case on the ground that the applicants are barred a patent by reason of the provisions of paragraph (d) of Section 102 of Title 35, United States Code.

The following publications will be referred to:

German Auslegeschrift 1,013,861 published August 14, 1957.

German Patentschrift 1,013,861 published April 11, 1958.

[1] Serial No. 717,732, filed February 26, 1958

[2] Composed of five members.

Patentblatt Aug. 14, 1957 Columns 3949-50, 3976.

Patentblatt Jan. 23, 1958 Columns 381, 398.

Section 102(d) of Title 35 U.S.C. provides that a patent cannot be obtained if:

> The invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States.

The present application was filed on February 26, 1958. Over three years earlier, on October 4, 1954 applicants had filed an application for patent for the same invention in Germany, Application No. F 15842 V/37d, and the invention has since become patented in Germany on the basis of that application. There is no dispute as to the inventions and the parties being the same, the only question raised being the time when the invention was patented in Germany. If the invention was patented in Germany prior to February 26, 1958, then a patent in the United States is barred to applicants by Section 102(d) of the Statute. On the other hand, if the invention was not patented in Germany until after the date mentioned, a patent is not so barred.

The Examiner asserts that the invention was patented in Germany prior to February 26, 1958, the filing date in the United States, and hence a patent is barred by the terms of Section 102(d). The Examiner's conclusion is based upon a notice which appeared in the Patentblatt (Patent Gazette) for January 23, 1958, which announced that the patent had been granted. The Patentblatt, the official journal of the German Patent Office, contains a section of announcements of granted patents. This section is headed "Grants" (Erteilungen), and its pages carry the running head "Patents".

. . . . . .

> Appellants do not deny the publication of the notice, its correctness, or its date. In fact, appellants do not and cannot deny that the patent rights were legally in existence, were vested to the fullest extent that patent rights become vested in Germany, and were enforceable, at the time. The position taken is essentially that a later date, namely April 11, 1958, when the specification of the patent, identified as such, was issued in printed form, should be taken as the date the invention was patented in Germany. This position cannot be accepted. It is elementary and requires no citation of authority that the mere issuance of the specification of a patent in printed form is unessential to the question of whether an invention has been patented in a foreign country. * * *

The board, consisting of five rather than the usual three members, unanimously rejected appellant's arguments and affirmed the examiner's holding.

In urging this court to reverse the board, appellants assign as their reasons:

> 1. It was error to affirm the decision of the Examiner in his rejection of claims 10 to 16.
>
> 2. It was error to refuse to allow the rejected claims.

In challenging the legal adequacy of those reasons the Government states in its brief:

> Like section 4912 R.S., 35 U.S.C. 142 provides that, when an appeal is taken to this Court, the appellant shall file in the Patent Office "his reasons of appeal, specifically set forth in writing." Similarly to section 4914 R.S., 35 U.S.C. 144 specifies that the decision of this Court "shall be confined to the points set forth in the reasons of appeal." *In re Dichter*, 27 CCPA 1060, 110 F.2d 664, involved reasons of appeal essentially the same as appellants' present reasons of appeal. Those reasons of appeal read, as follows:
>
> 1. The Board of Appeals was in error in rejecting claims 2, 3, 7, 8, 13, 16, 18, and 19.

2. The Board of Appeals was in error in not allowing claims 2, 3, 7, 8, 13, 16, 19, and 19.

3. The Board of Appeals was in error in affirming the decision of the Primary Examiner as to claims 2, 3, 7, 8, 13, 16, 18, and 19.

In dismissing Dichter's appeal, this Court said:

> The alleged reasons of appeal filed herein on February 16, 1939, are merely statements that the Board of Appeals erred. They contain no specification as to what error the board committed. If, in fact, the board did commit error it has not been pointed out. The alleged reasons of appeal lack vitality, and, in reality are not reasons of appeal within the meaning of the statute. The appellant, therefore, has failed to comply with section 4912 R.S., *supra*, and his failure to do so precludes our consideration of the appeal because section 4912 R.S., *supra*, which provides that this court shall "revise the decision appealed from" also provides that "*the revision shall be confined to the points set forth in the reasons of appeal.*" It being mandatory that we confine our revision "*to the points set forth in the reasons of appeal,*" and there being no points set forth in the notice of appeal filed herein, we are without authority to revise the decision of the board. See *In re Thomas & Hochwalt*, 23 C.C.P.A. (Patents) 1238, 83 F(2) 902; and *In re Wheeler*, 23 C.C.P.A. (Patents) 1241, 83 F. (2) 904.

Similar rulings were made in *In re Wesselman*, 29 CCPA 988, 127 F.2d 311. See also *In re Rosenblatt*, 28 CCPA 1036, 118 F.2d 590.

On the other hand appellants argue that there is but one issue and one reference here, therefore, no matter what criterion is used, their reasons of appeal are sufficient, emphasizing that the solicitor, in his brief, "fully discussed and applied the references." [sic] Appellants also rely on *In re Kopplin*, 32 CCPA 848, 146 F.2d 1014, 64 USPQ 463, and *In re Howell*, 49 CCPA 922, 298 F.2d 949, 132 USPQ 449, and cases there cited.

For many years Congress has prescribed certain criteria governing appeals to this court. Its latest expression came in 1952 when it re-enacted, virtually intact, R.S. 4912 and 4914 into what are now sections 142 and 144, respectively.

Section 142, governing notice of appeal, directs that:

> When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, *and shall file in the Patent Office his reasons of appeal, specifically set forth in writing*, within such time after the date of the decision appeal from, not less than sixty days, as the Commissioner appoints. (Emphasis supplied.)

Section 144 directs this court to:

> * * * hear and determine such appeal on the evidence produced before the Patent Office, *and the decision shall be confined to the points set forth in the reasons of appeal.* Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case. (Emphasis supplied.)

Returning to appellants' argument, we find no reference in Section 142 to the contents of *briefs*, or any basis therein for permitting appellants to rely on their *brief* to cure defective reasons of appeal. The law requires that appellants shall file in the Patent Office their reasons of appeal specifically set forth in writing. As this court said in *In re Wesselman*, 29 CCPA 988, 127 F.2d 311, 53 USPQ 365:

> * * * we would observe that in appellant's *brief* he contends that it was improper under the circumstances to join his copending patent application with the disclosure of the Johnson patent, and, secondly, that even though such joining was proper, nevertheless the combination is patentable.
>
> *It is so obvious that these matters should have been set forth in appellant's reasons of appeal that further discussion is unnecessary.* (Emphasis supplied.)

Although two references were cited in *Wesselman*, there was but one issue there as here.

We are familiar with *Kopplin* and *Howell* relied on by appellants. We are also familiar with *In re LePages, Inc.*, 50 CCPA 852, 312 F.2d 455, 136 USPQ 170, and with *In re Arnold*, 50 CCPA 1166, 315 F.2d 951, 137 USPQ 330, subsequently decided.[3]

We find nothing in the various cases cited by opposing counsel sufficiently in point with the facts here to be controlling. In all the cited cases the facts were different as they are here. It should go without saying that each case must necessarily be decided on its own facts.

Here, appellants content themselves with nothing more than broad allegations that the board erred. They fail to *specifically* state what error or errors the board allegedly committed on which appellants rely for reversal.

In *In re Rosenblatt*, 28 CCPA 1036, 118 F.2d 590, 49 USPQ 117, the court stated:

> In the case of *In re Laura Schneider*, 17 C.C.P.A. (Patents) 952, 39 F.2d 278, which came before us *during the first year of our patent jurisdiction*, we had occasion to say:
>
> *"Those appealing to this court should give to the the court by specific assignments and with particularity all grounds of* alleged error upon which they rely."
>
> The reason for and the philosophy of the rule, even aside from the statutory provisions, are so clear that no extensive discussion of those matters need be indulged. *This court does not wish to seem supertechnical, but it is entitled to have from those appealing a*

[3] See also *In re Sebald*, 31 CCPA 1148, 143 F.2d 366, 62 USPQ 90; *In re Boyce*, 32 CCPA 718, 144 F.2d 896, 63 USPQ 80; *In re Clark*, 44 CCPA 974, 214 F.2d 148, 102 USPQ 241; *In re Wagenhorst*, 20 CCPA 991, 64 F.2d 780, 17 USPQ 330, and *In re O'Brien*, 46 CCPA 851, 265 F.2d 940, 121 USPQ 461.

clear and specific statement of the exact points relied upon, and upon this we must insist. * * * (Emphasis supplied.)

That those appealing to this court have found no difficulty in heeding that admonition is evident from the fact that in only a handful of the thousands of appeals have the reasons of appeal been held defective.

To hold that the instant reasons of appeal are adequate would necessarily require us to ignore what Congress has expressly directed, or to stretch the statute to a point we are confident Congress did not intend. This court has no authority to follow either course. The appeal is *dismissed.*

DISMISSED

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

October Term 1962
Patent Appeal No. 6885
Serial No. 717,732

IN THE MATTER OF THE APPLICATION OF
FRIEDRICH GRUSCHWITZ AND ALBERT FRITZ

July 26, 1963

MARTIN, *Judge*, concurring.

As I stated in PA 6898, which has identical reasons of appeal,[1] it should be remembered that the question of whether specific reasons of appeal are adequate depends

[1] The same reasons of appeal can also be found in *In re Arnold and Brandt*, 50 CCPA 1166, 315 F.2d 951, 137 USPQ 330.

upon the factual situation in the appeal in which the particular reasons are filed. Where in one case the reasons of appeal set forth by appellant would be sufficient, the same reasons in another appeal involving a different set of facts might not be adequate.

Therefore when an appeal is dismissed, I believe it is incumbent upon us to state specifically wherein the reasons of appeal are insufficient. Here, it seems to me that since there are several dates involved, any one of which could be determinative of the issues here presented, appellants failed to comply with the provisions of 35 U.S.C. 142 in not setting forth their position as to the board's disposition of these dates in their reasons of appeal. Under these circumstances I would dismiss this appeal.

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

October Term 1962
Patent Appeal No. 6885
Serial No. 717,732

IN THE MATTER OF THE APPLICATION OF
FRIEDRICH GRUSCHWITZ AND ALBERT FRITZ

July 26, 1963

RICH, *Judge*, dissenting.

About a year and a half ago this court unanimously found two very general reasons of appeal sufficient to comply with 35 U.S.C. 142, over Patent Office protest.[1] Three claims were under rejection as unpatentable over four references. We said:

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[1] *In re Howell, Jr.*, 49 CCPA 922, 298 F.2d 949, 132 USPQ 449.

> The "Reasons of Appeal" in appellant's notice of appeal to this court are that the Board of Appeals erred (1) in rejecting claims 22, 23 and 24 on the Sollmann, Benzel, Cowen and Connell patents and (2) in not allowing claims 22, 23 and 24.

The bar was advised of the procedural "law" represented by this decision in an accurate headnote reading, "Notice of appeal to court is sufficient where it states that Board erred (1) in rejecting specific claims on enumerated patents and (2) in not allowing specific claims." Citing prior authority for our unanimous position we quoted, as expressing our views, from another unanimous decision of eighteen years ago,[2] in which the court said,

> Appellant has clearly advised us and the Patent Office of the issue, and it is not necessary for us to search the record in order to discover the basis of the appeal. The Solicitor in his brief discussed and applied all of the references. Therefore we will consider all of them.

The reason of appeal in the quoted case said, "The Board of Appeals erred in rejecting said claims and each of them for the reasons and on the references cited against them, respectively." In the cited case the court also pointed out that although the references were not specifically mentioned in the reasons of appeal, "That reason is the equivalent of setting out in separate reasons of appeal the Dodge, Fowler and Novotny patents."

Only a few weeks ago we handed down another decision (three to two)[3] in which we held, in a case involving ten claims, rejected on one reference, that the following reasons of appeal were *sufficient* in law:

---

[2] *In re Kopplin*, 52 CCPA 848, 146 F.2d 1014, 64 USPQ 403.

[3] *In re Arnold and Brandt*, 50 CCPA 1166, 315 F.2d 951, 137 USPQ 330, April 25, 1963.

1. It was error to affirm the decision of the examiner in his rejection of claims 18 to 28.

2. It was error to refuse to allow the rejected claims.

We noted at that time an apparent inconsistency between *In re Kopplin*, note 2, supra, and the early case of *In re Dichter*, 27 CCPA 1060, 110 F. 2d 664, 45 USPQ 91. We said we could see "no *significant* difference in the language of the reasons of appeal in the *Kopplin* case and the language used in the case before us." We followed *Kopplin*. We also said, "There really is no hard and fast rule upon which we can rely." But now we seem to have at least a *hard* rule. For what reason?

At least some of us felt that in making these decisions we were in accord with the spirit of the times and on the path of policy developments of the past quarter century to subordinate unnecessary and useless procedural technicalities wherever possible, get away from the sporting theory of justice, and get on with the business of deciding cases on their merits when there was no real obstacle to our doing so.

Now a new technical "majority" (again three to two but agreeing only on result) is making an about-face for the court and retreating into the barren world of useless legal technicalities from which we were so hopefully emerging. There is no compelling reason for such a retreat, as I shall presently demonstrate, and the majority does not make even a gesture toward suggesting there is one. It merely alines itself with selected old cases which put a narrow construction on the statute, ignoring the entirely inconsistent line of old and, especially, recent cases which give it a broader construction more in keeping with the realities of present procedure, which I explained in the *LePage's* case.

What I say here has equal applicability to the case of *In re Timmerbeil et al.* (No. 6898), decided concurrently

herewith, so some of my remarks may be directed to statements made in the majority of other opinions in that case. My general views on the subject of reasons of appeal and the historical background of the subject will be found in my concurring opinion in *In re LePage's Incorporated*, 50 CCPA 852, 312 F. 2d 455, 136 USPQ 170. I will try not to repeat myself.

Congress writes the statutes. The courts have to construe and apply them. In 1839 the Congress, under conditions somewhat different from those now prevailing in our courts, wrote into the statutes the expression "*reasons of appeal specifically set forth in writing.*" It was 90 years before a Court of Customs and Patent Appeals came into existence in 1929 to construe those words as they then applied to it and to its practice. During the next 34 years it gave to them a bewilderingly inconsistent construction, sometimes fiercely literal and restrictive, sometimes inexplicably liberal, most of the time accepting the reasons presented to it without comment because their sufficiency was not challenged, so that the opinions in most decided cases do not reflect the nature of the reasons filed, which were diverse, or the time wasted in writing and reading them—or saved by not reading them. The "handful" of cases in which the inadequacy of reasons of appeal has been questioned to a sufficient extent to merit discussion in an opinion is very close to a hundred, since the creation of this court in 1929, and the cases in which they have been discussed show that either a reason was found bad or the lack of a reason was found to bar consideration of a point on the merits in a majority of that "handful" of cases.[4] That is a substantial amount of difficulty for the bar and especially for the litigants, based on a procedural technicality.

I do not wish to obscure the fact that most of the time this court has taken a technical and rigid view of reasons

[4] See Appendix to this opinion.

of appeal. Rather, I emphasize the fact because many a litigant has been the loser for failure to file a proper reason. Except for the *LePage's* case, I have found no reported case where there was a total absence of reasons. In fact, most of the trouble seems to have arisen in cases where *many* reasons were filed but some specific point was overlooked in drafting them. Another interesting fact which appears in reading the cases is that under a compulsion to cover every point that *might* be argued, many reasons have been filed which are never argued in briefs and often the court, after reading the reasons, reading the briefs, and comparing the two, has performed the useless ritual of pointing out allegations of error which have thus been abandoned, giving them official burial. A point not argued is abandoned, whether or not backed up by, or based on, a reason of appeal. But why compel the filing of useless reasons?

Many laws, especially those dealing with procedure, become obsolete with the passage of time and changing conditions. When they do, they must be changed; and in our ever-lagging legal system there are two ways to do it. This court, which is intimately familiar with its own procedure, can, and in recent years has, by permissible construction of broad statutory language, tried to adapt the law to change and thus keep up with the times. This is sometimes called "liberal construction." The alternative is to resist all adaptation and insist on what, in an earlier day, has been decided to be the letter of the law until procedure gets so far behind the facts of the world in which it operates that a disgusted public demands a change through the legislature, to the detriment of the reputation of the law and lawyers. The flame could have been tempered to the condition of the stew but the pot has been left to boil over.

The decision the majority has made here is a most significant turning point, clearly calling for corrective legislation which is long past due.

I am as aware, at least, as is the majority that the construction it is putting on the reasons of appeal provisions in 35 U.S.C. 142, 143 and 144 has been put on the predecessors of those sections many dozens of times. But it is not a necessary construction. What the words "reasons of appeal, specifically set forth in writing," "points involved by the reasons of appeal," and "points set forth in the reasons of appeal"—century-old language—actually mean cannot be determined merely by reading them. They are vague terms. What is a "reason of appeal"? How specific is "specifically set forth"? What is a "point involved by" a reason of appeal? What "points" are "involved" by the reasons filed in this case? It seems transparently obvious to me that the terms mean what this court says they mean. As the judiciary, it is our proper function to determine the meaning of such unclear and unspecific terms in the statutes given into our charge to construe and to work under. We should determine their meaning so as to simplify practice and procedure, speed up our work, and hold down cost. This is not being done in this case, or in appeal No. 6898.

Historically this court has given those statutory phrases a variety of meanings and cases can be selected to support any *a priori* decision as to what they mean that a majority cares to make. Having reached a decision here, the majority cites certain cases in support of it. For each there is a mate, going the other way, which *could* have been cited to support a decision that we *can* reach the merits of the case. The majority does not even mention some of these cases.

The first case relied on by the majority is *In re Wesselman*. Against that I would match *In re Wagenhorst*, 20 CCPA 991, 64 F. 2d 780, 17 USPQ 330. In *LePage's* I discussed their inconsistency in reaching opposite results on substantially identical reasons of appeal, which, incidentally, were practically identical in form with the rea-

sons filed in this case. I leave the details to my *LePage's* opinion but do repeat the cogent observation of Presiding Judge Graham that

> There seems to be no real necessity, in order to raise the question here, that each ground of refusal given by the examiner and affirmed by the board, should be set out, seriatim.

There is still no necessity, and the majority opinion does not point one out, so far as I can discover.

In *Wagonhorst*, to put the real import of that decision beyond question, the court, in a case appealing six claims rejected on ten references, held a reason of appeal substantially like that before us to be a *sufficient* reason of appeal to comply with R.S. 4912 requiring "reasons of appeal, *specifically* set forth in writing." (My emphasis.) And the court added what I think is better reasoning than the cases quoted by the majority (which do not give *reasons* but mere conclusions), as follows:

> This court is not disposed to apply, in these cases, the rigid and inflexible rules as to assignments of error sometimes applied by the courts in other proceedings. The statute should be liberally and reasonably construed and its purpose to give to parties appealing to this court from Patent Office decisions a speedy and effective revision thereof, should not be defeated by a highly technical construction of the written "reasons of appeal." If the court and the Patent Office are advised, by these written reasons, of the questions at issue, that is sufficient to enable the court to "revise the decision appealed from in a summary way." Section 4914 R.S. [Now 35 U.S.C. 144.]

The next case relied on by the majority is *In re Dichter*, the opinion in which was written by Judge Jackson in 1940. Against this case I match the case of *In re Kopplin*, cited but not discussed by the majority except to say that

it was presumably "decided on its own facts," no attempt being made to reconcile it. That case was decided in 1945 and the opinion was also written by Judge Jackson. Both decisions were unanimous. The *Kopplin* case involved eleven claims rejected on four references. I have quoted the reason of appeal at the beginning of this opinion. It did not even state the numbers of the appealed claims. Though *more vague* than the reasons before us here, it was held to be in compliance with the statutes. Assuming the case was decided on its own facts,—and what case is not—they show that a reason even less specific than the three reasons in the earlier *Dichter* case and the two reasons here could, in the unanimous opinion of this court, comply with the specificity which Congress is supposed to have required in reasons of appeal.

Finally, the majority quotes from *In re Rosenblatt*, which quotes in turn from *In re Schneider*, a case decided in the *first* year of this court's jurisdiction over patent appeals. The two quotations express the sentiment of the court in those far off days that *it was entitled* to specific assignments of error, set forth with particularity, "even aside from the statutory provisions." But here the majority purports to be resting its construction not on its views as to the specifications of error to which it feels it is *entitled* but on the presumed mandate of the legislature. I respectfully submit that this "mandate" is purely imaginary and entirely self-inflicted.

The majority opinion here is not consistent with others in which the said mandate, if it is what it is said to be, was not so rigidly adhered to. As an offset to the *Rosenblatt* case I suggest *Bluestone* v. *Schmerling*, 46 CCPA 842, 265 F. 2d 948, 121 USPQ 417. There, in 1959, a unanimous court said:

> It is questionable whether the issue of *res judicata* is properly before this court *since it was not specifically raised by any reason of appeal.* [Emphasis mine.]

In the succeeding two paragraphs we went right ahead and decided the res judicata issue on the merits. Thus we considered and decided an issue raised by the appellant which was admittedly not raised by *any* reason of appeal. Yet, according to the portion of the *Dichter* case quoted in the majority opinion, we are "without authority to revise the decision of the board" with respect to issues not raised by the reasons of appeal.

The next case I might mention from the same volume is *In re O'Brien*, 46 CCPA 851, 265 F. 2d 940, 121 USPQ 461, another unanimous decision, insofar as the issue relating to reasons of appeal was concerned. In that case there was a very unusual notice of appeal containing one reason of appeal and four alleged "errors," which, as stated in the opinion, failed to mention two of the references relied on and which did not specifically mention any claims. The Patent Office challenged their sufficiency and relied on the *Wesselman* case along with *In re Boyce*, 32 CCPA 718, 144 F. 2d 896, 63 USPQ 80, and *In re Glocker*, 33 CCPA 789, 153 F. 2d 119, 68 USPQ 194. The opinion went to some pains to distinguish all three of these cases (unlike the opinions in the instant cases) in order to reach a decision on the merits of the rejection of the unspecified claims on the unmentioned references. What of the "specificity" supposedly required by statute?

If the last two recent cases are good law, it seems to me that the bar may have some difficulty in deciding just what a majority of this court thinks is necessary—as a matter of "law"—to include in reasons of appeal to get a decision on the merits.

The really significant intendment of the statute is that we are a court of *review* and are not to act in any case on *new* grounds which we originate but are to restrict ourselves (and the statutes so restrict us) to passing on the legality of what has been decided below. We are "confined," and so we must confine ourselves, to "the points

set forth in the reasons of appeal," 35 U.S.C. 144. *In re Tucker et al.*, 19 CCPA 810, 54 F. 2d 815, 12 USPQ 131. But as for deciding what "points" are raised by any given reason of appeal, among those decided below, this court has now, and always has had and exercised, complete freedom, never curbed by any higher authority. It is we who determine what *are* "the points involved by the reasons of appeal" and what is meant by the phrase "specifically set forth in writing." In changing the construction the court has put on these words for the past decade, one would justifiably expect the majority to state a *reason* for doing so. But since there is none, its absence is not surprising.

Two additional cases which I might mention as denying the existence of any straightjacket placed on this court by the statutes are *In re Woodling*, 41 CCPA 809, 210 F. 2d 955, 101 USPQ 108, and *In re LeBaron*, 42 CCPA 956, 223 F. 2d 471, 106 USPQ 176. In the *Woodling* case, the Patent Office Solicitor called attention to the fact that there were two grounds of rejection untouched, either expressly or by implication, by the reasons of appeal so that the appeal could (and should, it was urged) have been dismissed under the rule of *In re Boyce*, 32 CCPA 718, 144 F. 2d 896, 63 USPQ 80. The court, however, after pointing to the existence of this state of facts, proceeded to the consideration of a third ground of rejection on the merits, sustaining that rejection. The *In re Boyce* rule, of course, is to the effect that if there is an outstanding ground or rejection untouched by the reasons of appeal, the court *must* affirm the Patent Office no matter what other points are argued. Other considerations, theoretically, become moot.

In the *LeBaron* case a unanimous court accepted broad "reasons" as adequate to enable it to pass on the merits of the case, which it proceeded to do. The reasons were thus described:

> • • • appellant's reasons of appeal are general in form, alleging that the "Board of Appeals' erred in affirming the Primary Examiner's rejection upon [references],"• • •.

One point assumed to have been raised by such "reasons" was held to have been abandoned by failure to argue it in appellant's brief but nothing was said to indicate that the "general" reasons of appeal were not entirely adequate. That was in 1955. From that time to this, I do not believe we have ever refused to consider a question for the sole reason that there was no reason of appeal "touching" it.

Whenever the court has wished to review a question considered below under the all-inclusive general type of reasons such as we have here, it has done so, and can now do so. The truth of this assertion is to be found in our decisions in the *Wagenhorst*, *Kopplin*, *Bluestone* v. *Schmerling*, *O'Brien*, *Woodling*, *LeBaron*, *Howell* and *Arnold et al.* cases. What we had authority to do there, we have the authority to do here.

Another large field in which we pass on issues not specifically raised by reasons of appeal without giving the matter a second thought is in appeals in interferences. An early case illustrating this fact is *Kratz et al.* v. *Calvert*, 29 CCPA 1097, 129 F. 2d 542, 54 USPQ 264. Clearly the court did not there regard the absence of a reason of appeal as having any affect on its "jurisdiction" or power to decide a question it wanted to decide. The question was the derivation of the invention by Kratz et al. from Calvert—a question of originality. The court pointed out:

> • • • appellants *made no reference to it in the reasons of appeal* stated in the appeal to us. Notwithstanding this omission, however, appellee has raised and argued the question before us, and for reasons hereinafter stated, we think it is involved and should be decided.
>
> • • • • • • • •

> [3] As has been stated, *the question of originality was not referred to in the reasons of appeal* stated in the appeal to us, nor was it discussed at any length in appellants' brief before us in this case. • • • Appellee, however, has raised the question and discussed it elaborately. It is a question ancillary to priority and *appellee has the right to raise it and have it determined.* [My emphasis.]

The court then proceeded to decide the case on that sole ground and did not consider "other questions raised in the reasons of appeal." Augmenting the foregoing decision, see *Klemperer* v. *Price*, 47 CCPA 729, 271 F. 2d 743, 123 USPQ 539, from which it is clear that in an interference we will consider any question, decided adversely to a successful party, on the appeal of the loser, if the question is ancillary to priority and regardless of the reasons of appeal filed by the appellant. The successful party is not allowed to appeal and so no reasons of appeal are filed by him.

In his concurring opinion in this case, Judge Martin finds the supposed insufficiency of the reasons here to reside in the *fact* (external to the reason *per se*) that "there are several dates involved, any one of which could be determinative of the issues here presented." I cannot agree with this analysis of the facts. One reference only is relied on as a statutory bar under 35 U.S.C. 102(d) and the sole question is when that reference became a "patent" in Germany. The Patent Office relies on a single date, January 23, 1958.[5] The sole issue here is whether that date is correct. If appellant can establish that there was *no* patent on that date, he wins. Appellants' simple argument is that there was no patent on January 23, 1958, because the pat-

[5] The Examiner's Answer relied only on this date, the date of the "Patentblatt" containing the notice that the patent had been granted, which date was prior to appellants' filing date of February 26, 1958.

enting date was April 11, 1958, a date which is, of course, too late to support the Patent Office rejection.

But even if there were an argument involving "several dates" in this case, in the precedents I have cited the court found to be acceptable reasons of appeal which were substantially the equivalent of those here in cases where there were multiple issues involving multiple claims, multiple references, and multiple grounds of rejection. On the basis of those precedents, therefore, I say with respect to Judge Martin's comments in both this case and in No. 6898, the *Timberbeil et al.* case, that the existence of "several dates" or "several references" does not *necessitate* a holding that the reasons of appeal are not "adequate." Some better reason than that must be found to square with our decision in the *Arnold and Brandt* case, in which we said, "There really is no hard and fast rule," and held adequate reasons the same in form as those here and in No. 6898, opinion by Judge Martin.

As an interesting bit of history of the operations under these statutes, which have not been changed in their requirements since 1839—so that, necessarily, it was the same law—the "Rules and Directions for Proceedings in the Patent Office" of August 1, 1869, which were the first to include forms showing how to write reasons of appeal, set forth the following with official approval (Form 31):

> And the said George Thompson assigns the following reasons for appealing from the said decision of the Commissioner of Patents, viz:
>
> The Commissioner erred in deciding that the said improvement was not patentable.
>
> The Commissioner erred in deciding that the said invention was not new.
>
> The Commissioner erred in deciding that the said invention was not useful.
>
> The Commissioner erred in refusing a patent (or reissue) to appellant.

[If the appeal be from the decision of the Commissioner in a case of interference, the reasons may be as follows:]

The Commissioner erred in awarding priority of invention to William Brown.

The Commissioner erred in not awarding priority of invention to appellant.

These were repeated in the rules dated November 1, 1869. The rules of July 1870, the year of the consolidated patent act, gave the same form (Form 32) but included only the first two reasons.

The August 1871 "Rules of Practice of the United States Patent Office" made a radical change. Form 34 included the instruction which, in my *LePage's* opinion, I quoted from the 1886 rules, namely:

> 34. * * * (Here follow reasons, which should be full and explicit, and constitute a brief of appellant's argument.)

In 1897 the form provided by Patent Office rules was again changed and the above advice was replaced by the following:

> 34. * * * [Here set out in separate counts the specific errors in the Commissioner's decision complained of.]

The equivalent was continued into the 1950's.

The present Patent Office rules provide no form at all.

We thus see that official sanction has been given to reasons of appeal which are little more than formalities and that at another period the reasons of appeal metamorphosed into a brief of the argument. There is no question but that practice has changed through the years—but the statutes have remained the same.

It seems to me that the majority is now confusing statutory *mandate* with *mere matters of practice* as the court has at times in the past chosen to enforce them.

For a generation (1839-1870), reasons of appeal such as we have here were officially regarded as being in compliance with the predecessor statute to 35 U.S.C. 142. It is self-evident that there is literal compliance. The reasons here are (1) "*reasons* of appeal"; (2) they *specify* that the error of the Commissioner was in affirming the rejection of claims 10 to 16 and in not allowing those claims; and (3) they certainly are "set forth in *writing*." Beyond that, if we require anything more, we do so not because we are compelled by the statute to do so, but just because we want to. We should not pretend otherwise. For a decade, at least, we have not been requiring more.

For the reasons above stated, I cannot see the slightest excuse for reversing the procedural law that we have so recently reaffirmed in the *Howell* and *Arnold et al.* cases, without even an attempt to reconcile them, to the utter bafflement of the bar, the dismay of the litigants, and the denigration of their attorney's professional reputation.

I would decide the case on the merits.

I wish to express agreement with Judge Smith's dissenting opinion in *In re Timmerbeil et al.* (No. 6898) decided concurrently herewith.

APPENDIX

The Foregoing Opinion is Based on a Study of the Following 92 Court of Customs and Patent Appeal Cases Involving Reasons of Appeal

In re Smith, 17 CCPA 752, 36 F. 2d 522; 4 USPQ 235;
In re Schneider, 17 CCPA 952, 39 F. 2d 278, 5 USPQ 57;
Jantzen Knitting Mills v. *West Coast Knitting Mills*, 18 CCPA 1142, 47 F. 2d 954, 8 USPQ 561;
In re Perrigo, 18 CCPA 1323, 48 F. 2d 965, 9 USPQ 152;
Brydle v. *Honigbaum*, 19 CCPA 773, 54 F. 2d 147, 11 USPQ 219;
Mas v. *Root*, 19 CCPA 819, 54 F. 2d 435, 12 USPQ 13;
Southgate v. *Greene*, 19 CCPA 1129, 57 F. 2d 374, 13 USPQ 160;
Derby Oil Co. v. *White Star Refining Co.*, 20 CCPA 816, 62 F. 2d 984, 16 USPQ 297;
In re Wagenhorst, 20 CPA 991, 64 F. 2d 780, 17 USPQ 330;
In re Muller, 20 CCPA 1162, 65 F. 2d 169, 18 USPQ 24;
Osgood v. *Ridderstrom*, 21 CCPA 1176, 71 F. 2d 191, 22 USPQ 35;
Helen Scky-Man-Ski & Sons, etc. v. *S. S. S. Co.*, 22 CCPA 701, 73 F. 2d 624, 23 USPQ 286;
In re Lawson, 22 CCPA 1016, 75 F. 2d 633, 24 USPQ 419;
In re Thomas et al., 23 CCPA 1238, 83 F. 2d 902, 30 USPQ 22;
In re Wheeler, 23 CCPA 1241, 83 F. 2d 904, 30 USPQ 20;
In re Ferenci, 23 CCPA 1273, 84 F. 2d 394, 30 USPQ 50;
Daley v. *Trube*, 24 CCPA 964, 88 F. 2d 308, 39 USPQ 571;
In re Dichter, 27 CCPA 1060, 110 F. 2d 664, 45 USPQ 91;
In re Jeffery, 27 CCPA 1311, 112 F. 2d 827, 46 USPQ 83;
In re Rosenblatt, 28 CCPA 1036, 118 F. 2d 590, 49 USPQ 117;
In re Davis et al., 29 CCPA 723, 123 F. 2d 651, 51 USPQ 458;
In re Wesselman, 29 CCPA 988, 127 F. 2d 311, 53 USPQ 365;
Kratz et al. v. *Calvert*, 29 CCPA 1097, 129 F. 2d 542, 54 USPQ 264;
In re Rothenberg et al., 29 CCPA 1230, 129 F. 2d 706, 54 USPQ 417;
In re Cohen, 30 CCPA 876, 133 F. 2d 924, 56 USPQ 567;
Paulson v. *Hyland*, 30 CCPA 1150, 136 F. 2d 695, 58 USPQ 275;

Boileau v. Godfrey, 31 CCPA 723, 138 F. 2d 67, 59 USPQ 149;
In re Langsner, 31 CCPA 785, 139 F. 2d 512, 60 USPQ 189;
Mantz v. Jackson, 31 CCPA 824, 140 F. 2d 161, 60 USPQ 329;
In re Sassman, 31 CCPA 921, 141 F. 2d 267, 60 USPQ 538;
In re Hanson, 31 CCPA 992, 141 F. 2d 508, 61 USPQ 119;
Poulsen et al. v. McDowell, 31 CCPA 1006, 142 F. 2d 267, 61 USPQ 342;
Franco-Italian Packing Food Corp. v. Van Camp Sea Food Co., Inc., 31 CCPA 1020, 142 F. 2d 274, 61 USPQ 369;
In re Kingston, 31 CCPA 1050, 142 F. 2d 259, 61 USPQ 411;
Mitchell v. Hennion, 31 CCPA 1129, 143 F. 2d 623, 62 USPQ 81;
In re Schuh, 31 CCPA 1148, 143 F. 2d 366, 62 USPQ 90;
Yeates v. Ruer, 31 CCPA 1172, 143 F. 2d 607, 62 USPQ 137;
In re Brodlander, 31 CCPA 1190, 143 F. 2d 982, 62 USPQ 309;
The Virgin Corp. v. The Knox Co., 31 CCPA 1205, 143 F. 2d 883, 62 USPQ 276;
Weco Products Co. v. Milton Ray Co., 31 CCPA 1214, 143 F. 2d 985, 62 USPQ 314;
In re Boyce, 32 CCPA 718, 144 F. 2d 896, 63 USPQ 80;
In re Arter, 32 CCPA 882, 147 F. 2d 701, 64 USPQ 563;
In re Dalzell et al., 32 CCPA 938, 148 F. 2d 357, 65 USPQ 215;
In re Smith, 32 CCPA 1256, 150 F. 2d 700, 66 USPQ 306;
In re Voit et al., 33 CCPA 737, 152 F. 2d 387, 68 USPQ 206;
In re Glocker, 33 CCPA 789, 153 F. 2d 113, 68 USPQ 194;
In re Isler, 33 CCPA 791, 152 F. 2d 1002, 68 USPQ 198;
In re Weyland et al., 33 CCPA 837, 154 F. 2d 133, 69 USPQ 86;
In re Saunders et al., 33 CCPA 1001, 154 F. 2d 333, 69 USPQ 341;
In re Mark, 33 CCPA 1048, 155 F. 2d 276, 69 USPQ 527;
Harrington et al. v. Metesa, 33 CCPA 1073, 155 F. 2d 412, 69 USPQ 309;
In re Schaar, 33 CCPA 1079, 155 F. 2d 734, 69 USPQ 518;
Dreher et al. v. Braden, 33 CCPA 1130, 156 F. 2d 64, 70 USPQ 183;
In re Russell, 34 CCPA 721, 157 F. 2d 190, 71 USPQ 89;
In re Curtis et al., 34 CCPA 740, 158 F. 2d 300, 72 USPQ 116;

In re Emmey et al., 34 CCPA 1097, 161 F. 2d 754, 74 USPQ 38;
In re Ray, 35 CCPA 1088, 167 F. 2d 504; 77 USPQ 375;
In re Lindenblad, 35 CCPA 1132, 168 F. 2d 110, 77 USPQ 604;
In re Goldberg, 35 CCPA 1225, 168 F. 2d 527, 78 USPQ 69;
In re Irmscher, 36 CCPA 767, 171 F. 2d 303, 80 USPQ 136;
In re Crêmer et al., 36 CCPA 980, 173 F. 2d 376, 81 USPQ 160;
Kohl v. Wilms, 36 CCPA 1099, 175 F. 2d 466, 82 USPQ 173;
In re Delancey, 37 CCPA 760, 177 F. 2d 377, 83 USPQ 388;
Botnen v. Dorman, 37 CCPA 813, 179 F. 2d 249, 84 USPQ 270;
Miller v. Nemmer et al., 37 CCPA 866, 175 F. 2d 979, 84 USPQ 445;
In re Booge et al., 37 CCPA 927, 179 F. 2d 986; 84 USPQ 482;
Field v. Knowles, 37 CCPA 1211, 183 F. 2d 593, 86 USPQ 373;
In re De Vaney, 38 CCPA 735, 185 F. 2d 679, 88 USPQ 97;
In re Pappas et al., 38 CCPA 746, 185 F. 2d 695, 88 USPQ 108;
In re Tantarin, 38 CCPA 872, 187 F. 2d 160, 88 USPQ 490;
In re Strain, 38 CCPA 933, 187 F. 2d 737, 89 USPQ 150;
In re Dalton et al., 38 CCPA 953, 188 F. 2d 170, 89 USPQ 271;
In re Shao Wen Yuân, 38 CCPA 967, 188 F. 2d 377, 89 USPQ 324;
Kruger v. Resnick, 39 CCPA 994, 197 F. 2d 348, 94 USPQ 65;
In re Blood, 39 CCPA 1037, 197 F. 2d 545, 94 USPQ 189;
In re Worrest, 40 CCPA 804, 201 F. 2d 930, 96 USPQ 381;
In re Hultquist, 40 CCPA 927, 203 F. 2d 758, 97 USPQ 328;
In re Woodling, 41 CCPA 800, 210 F. 2d 355, 101 USPQ 305;
In re Naiman, 42 CCPA 914, 222 F. 2d 750, 106 USPQ 141;
In re LeBaron, 42 CCPA 959, 223 F. 2d 471, 106 USPQ 170;
St. Pierre v. Harvey, 43 CCPA 918, 233 F. 2d 337, 110 USPQ 47;
In re Chaplin, 44 CCPA 941, 240 F. 2d 249, 114 USPQ 197;
In re Storrs, 44 CCPA 981, 240 F. 2d 474, 114 USPQ 293;
In re Irons, 45 CCPA 774, 251 F. 2d 622, 116 USPQ 411;
Tolle et al. v. Starkey, 45 CCPA 979, 255 F. 2d 936, 118 USPQ 252

Bluestone v. *Schmerling*, 46 CCPA 842, 265 F. 2d 948, 121 USPQ 417;
In re O'Brien, 46 CCPA 851, 265 F. 2d 940, 121 USPQ 461;
Klemperer v. *Price*, 47 CCPA 729, 271 F. 2d 743, 123 USPQ 539;
Robert Hall Clothes, Inc. v. *Studds*, 48 CCPA 831, 286 F. 2d 615, 128 USPQ 542;
In re Griner, 48 CCPA 852, 287 F. 2d 178, 129 USPQ 61;
In re Howell, 49 CCPA 922, 298 F. 2d 949, 132 USPQ 449; and
In re Lorenz et al., 49 CCPA 1227, 305 F. 2d 875, 134 USPQ 312.

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

October Term 1962
Patent Appeal No. 6885
Serial No. 717,732

IN THE MATTER OF THE APPLICATION OF
FRIEDRICH GRUSCHWITZ AND ALBERT FRITZ

July 26, 1963

SMITH, *Judge*, dissenting.

For the reasons more fully set forth in my dissenting opinion in *In re Timmerbeil et al.*, PA 6898, I dissent from the majority opinion herein. I think the public interest requires us to pass on the question of substantive patent law which I think is squarely raised here by the reasons of appeal. I would hold the reasons of appeal to be sufficient and would dispose of this appeal on its merits.

INDEX

	Page
Opinions below	1
Jurisdiction	1
Questions presented	2
Statutes involved	2
Statement	3
Argument	4
Conclusion	10

CITATIONS

Cases:	
Dichter, In re, 110 F. 2d 664	7
Glidden Company v. *Zdanok*, 370 U.S. 530	4, 5
McBride v. *Teeple*, 311 U.S. 649	5
Pacific Northwest Canning Co. v. *Skookum Packers' Assn.*, 283 U.S. 858	5
Postum Cereal Co. v. *California Fig Nut Co.*, 272 U.S. 693	5
Statutes:	
Act of August 22, 1914, 38 Stat. 703	6
Act of March 2, 1929, c. 488, 45 Stat. 1475: Sections 1–4	5
Tariff Act of 1930, 46 Stat. 590, 762, 28 U.S.C. (1946 ed.) 308: Section 647	6
36 Stat. 1145	6
28 U.S.C. 1256	2, 6, 7
28 U.S.C. 1541	6
35 U.S.C. 102(d)	3, 8
35 U.S.C. 142	2, 7, 9
35 U.S.C. 143	9
35 U.S.C. 144	2, 7, 9

716-204—63

Miscellaneous:
H.R. 7553, 88th Cong., 1st Sess., introduced July 15, 1963 ..... Page 9, 10
Stern and Gressman, *Supreme Court Practice* (3d ed., 1962), Sec. 2-22 7

In the Supreme Court of the United States

OCTOBER TERM, 1963

No. 579

IN THE MATTER OF THE APPLICATION OF FRIEDRICH GRUSCHWITZ AND ALBERT FRITZ, PETITIONERS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE COMMISSIONER OF PATENTS IN OPPOSITION

OPINIONS BELOW

The opinions of the judges of the United States Court of Customs and Patent Appeals (Pet. 1a-26a) are reported at 320 F. 2d 401.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on July 26, 1963 (Pet. 1a). The petition for a writ of certiorari was filed on October 24, 1963. The petitioners invoke the jurisdiction of this Court under 28 U.S.C. 1256 (Pet. 2).

QUESTIONS PRESENTED

1. Whether this Court has jurisdiction to review on certiorari a decision by the United States Court of Customs and Patent Appeals in a case on appeal

from the Board of Appeals of the United States Patent Office.

2. Whether, in light of the statutory requirement that an appellant from the Patent Office to the Court of Customs and Patent Appeals set forth specifically his reasons for appeal, the Court of Customs and Patent Appeals was warranted in dismissing petitioners' appeal where their purported reasons for appeal stated no more than that the Patent Office erred in rejecting their application for a patent.

STATUTES INVOLVED

28 U.S.C. 1256 provides:

> *Court of Customs and Patent Appeals; certiorari.*—Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari.

35 U.S.C. 142 provides:

> When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints.

35 U.S.C. 144 provides with respect to decisions of the Court of Customs and Patent Appeals:

> * * * the decision shall be confined to the points set forth in the reasons of appeal.

STATEMENT

Petitioners, on February 26, 1958, applied to the Patent Office for a patent on a "Spray—Plastering—Device for Applying Mortar to Ceilings and Walls of Buildings," their asserted invention being contained in claims 10–16 of the application (Pet. 1a–2a). Both the examiner and the Board of Appeals of the Patent Office rejected their claims as unpatentable over a prior German patent issued to the petitioners (Pet. 1a). Specifically, the rejection over this reference was based on the provision in 35 U.S.C. 102(d), that an invention is not patentable if

> the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States.

The disputed question raised in the Patent Office proceedings involved the date when the invention was patented in Germany (Pet. 2a). If it was patented prior to February 26, 1958, as the Patent Office ruled, the present application was barred by section 102(d); but if the invention was patented after that date, as the petitioners contended, their application was not barred (Pet. 2a–3a).

In their notice of appeal from the Patent Office's Board of Appeals to the Court of Customs and Patent Appeals, the petitioners set forth as reasons for appeal the following (Pet. 3a):

1. It was error to affirm the decision of the Examiner in his rejection of claims 10 to 16.

2. It was error to refuse to allow the rejected claims.

A majority of the Court of Customs and Patent Appeals, in an opinion by Chief Judge Worley joined by Judge Jackson (Pet. 1a–7a), and a separate opinion by Judge Martin (Pet. 7a–8a), held that the reasons for appeal contained in the petitioners' notice were inadequate, and dismissed the appeal for want of jurisdiction. Judges Rich (Pet. 8a–26a) and Smith (Pet. 26a) dissented.

ARGUMENT

Recently this Court declined to rule on the question whether decisions of the Court of Customs and Patent Appeals, in patent cases on appeal from the Patent Office, are reviewable on certiorari. *Glidden Company* v. *Zdanok*, 370 U.S. 530, 578, n. 49. In our view there is no need for the Court to rule on that question in the instant case because the decision below is correct on the merits. There is a statutory requirement that an appellant in a patent case seeking review in the Court of Customs and Patent Appeals state in writing his reasons for appeal. The petitioners' purported statement, setting forth no more than that the Patent Office had erred, was in reality no statement of reasons for appeal. In addition, the question of the procedures to be followed in taking patent appeals to the Court of Customs and Patent Appeals is now before Congress in the form of a proposal to amend Title 35 of the United States

Code. Any issues arising from the Court of Customs and Patent Appeals' application of the procedural statutes here involved may well be obviated by Congressional action.

1. In *Postum Cereal Co.* v. *California Fig Nut Co.*, 272 U.S. 693, this Court held that a decision of the Court of Appeals of the District of Columbia, on appeal from a decision of the Patent Office relating to a patent and trademark application, was not a judicial determination but "merely an instruction * * * by a court which is made part of the machinery of the Patent Office for administrative purposes." 272 U.S. at 698–699. Since such a decision did not, in the Court's view, present a justiciable case or controversy, it was deemed beyond the constitutional powers conferred upon this Court.

The jurisdiction of the Court of Appeals for the District of Columbia Circuit over patent and trademark matters was subsequently transferred to the Court of Customs and Patent Appeals. Act of March 2, 1929, c. 488, Sections 1–4, 45 Stat. 1475. But the nature of the proceeding was not changed, and thereafter, in denying certiorari in *Pacific Northwest Canning Co.* v. *Skookum Packers' Assn.*, 283 U.S. 858 (trademark case), and in *McBride* v. *Teeple*, 311 U.S. 649 (patent case), the Court specifically noted that the denial was "for want of jurisdiction," citing *Postum Cereal*. In subsequent patent cases, the Court has merely denied certiorari, without more.

However, the basis for the decision in *Postum Cereal* was overruled in *Glidden Company* v. *Zdanok*, 370 U.S. 530. In light of the opinion in *Glidden*,

there is now no constitutional obstacle to review by this Court of patent rulings of the court below. The subsisting question is whether Congress intended to vest such jurisdiction in this Court.

Prior to 1948, the only statutory provision authorizing this Court to review decisions of the Court of Customs and Patent Appeals was one relating to customs cases. That provision—Section 195 of the old Judicial Code (36 Stat. 1145), as amended[1]—had two elements, one empowering the Court of Customs and Patent Appeals to hear appeals from the Customs Court in customs cases, and a second authorizing this Court to review such decisions. It did not refer to patent or trademark matters. In 1948, with the codification of Title 28 of the United States Code, the two elements of section 195 of the old Judicial Code were separated, with the former being placed in 28 U.S.C. 1541 and the latter in 28 U.S.C. 1256.[2] However, upon codification in 1948, the language of the provision dealing with this Court's certiorari jurisdiction was changed. Instead of providing only for certiorari in "customs" cases from the Court of Customs and Patent Appeals, 28 U.S.C. 1256 provides for review by this Court of "[c]ases in the Court of Customs and Patent Appeals." The terms of the statute are now sufficiently broad to cover all cases. But apart from

[1] Section 195 was amended by the Act of August 22, 1914, 38 Stat. 703, and by Section 647 of the Tariff Act of 1930, 46 Stat. 590, 762, 28 U.S.C. (1946 ed.) 308.

[2] The Revisers Notes to Sections 1256 and 1541 confirm the derivation of those provisions.

this change in wording, there are no indications, one way or the other, of Congressional purpose.

Militating against a construction of 28 U.S.C. 1256 as encompassing patent and trademark cases is the fact that there is nothing else in the codifying act or its legislative history suggesting that Congress had any design to provide for review of a class of cases over which jurisdiction had previously been withheld.[3] On the other hand, the wording of the statute is no longer limited. We do not urge that the question is one which would not warrant examination in an appropriate case. However, the instant case would not seem to be one which demands resolution of this jurisdictional issue.

2. Section 142 of 35 U.S.C. requires that, in addition to filing a notice of appeal, the appellant, in taking an appeal from the Patent Office to the Court of Customs and Patent Appeals, shall file with the Patent Office in writing his reasons for appeal. Section 144 of 35 U.S.C. provides that the decision of the court *must* be confined to the points set forth in the reasons for appeal. The Court of Customs and Patent Appeals has consistently held that, under these provisions, the requirements of adequate reasons for appeal is jurisdictional. *In re Dickler*, 110 F.2d 664.

In the present case, the Patent Office had held that the petitioners' invention had been patented in Germany prior to the application for a patent filed in the United States, and that the German application

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[3] See Stern and Gressman, *Supreme Court Practice* (3d ed., 1962), Sec. 2-22.

had been filed more than a year before the application in this country (R. 21–22, 32–44).* Since both of these factors were present, the American application was barred by 35 U.S.C. 102(d). The contested issue before the Patent Office was whether the German invention was patented on January 23, 1958, when a notice in the Patentblatt (Patent Gazette) announced that a patent had been granted, or whether it was patented in Germany on April 11, 1958, when the specification of the patent was issued in printed form in Germany (a date subsequent to the application in this country) (Pet. 2a–3a; R. 33–34). Underlying this issue were considerations of German patent law and practice, which the Patent Office's Board of Appeals discussed in detail (R. 34–42).

In light of the issue before the Patent Office, it would seem that the petitioners' statement of reasons for appeal should have alleged that the Patent Office erred in ruling that their invention was patented in Germany on January 23, 1958, instead of on April 11, 1958, and that, therefore, their application in this country was not barred by 35 U.S.C. 102(d). However, there was nothing contained in their reasons for appeal even remotely suggesting that this was their complaint.

These so-called reasons for appeal, stating no more than that the Patent Office erred, added nothing to the notice of appeal itself. To uphold such a statement would be to ignore the statutory requirement of spe-

* "R." refers to the Transcript of Record before the United States Court of Customs and Patent Appeals, which is part of the record in this Court.

cific assignments of error. As Chief Judge Worely pointed out below (Pet. 7a), "To hold that the instant reasons of appeal are adequate would necessarily require us to ignore what Congress has expressly directed, or to stretch the statute to a point we are confident Congress did not intend."

There is another factor militating against certiorari in this case. The jurisdictional requirement of reasons for appeal in patent appeals to the Court of Customs and Patent Appeals is currently being reexamined by Congress in connection with a bill pending before the House Committee on the Judiciary. See H.R. 7553, 88th Congress, 1st session, introduced July 15, 1963. This bill would amend sections 142, 143, and 144 of 35 U.S.C. for the purpose of conforming the procedures in patent appeals to those governing appeals from the district courts to the courts of appeal. Under the proposed bill, the appellant would only be required to file a statement of points if he designates as the record on appeal less than the complete patent office record. Furthermore, the proposed amendment provides that the failure to file a statement of points even where less than the entire record is designated "does not affect the validity of the appeal or the jurisdiction of the court to hear and decide the appeal or any point therein" and that this failure "is ground for only such action as the court deems appropriate, which may include dismissal of the appeal in whole or in part." Thus, the failure to file a statement of reasons for appeal would not be jurisdictional. Both the Department of Commerce

and the Department of Justice, before the House Judiciary Committee, have indorsed this provision of H.R. 7553.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 579

In the Matter of the Application of
FRIEDRICH GRUSCHWITZ and ALBERT FRITZ,
Petitioners.

FOR SPRAY-PLASTERING-DEVICE FOR APPLYING MORTAR TO CEILINGS AND WALLS OF BUILDINGS

REPLY BRIEF FOR THE PETITIONERS

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ARGUMENT

1. The principal reason that the respondent sets forth for denying the petitioners' petition for a writ of certiorari is that the decision below is correct. In support of this contention the respondent makes several statements which clearly point out that the decision below is the result of a factual misinterpretation by Judge Martin whose concurring opinion was the determinative one in the three to two decision of the Court of Customs and Patent Appeals.

Judge Martin stated his reason for concurring in the dismissal of the appeal as follows:

> "Here, it seems to me that since there are several dates involved, any one of which could be determinative of the issues here presented, appellants failed to comply with the provisions of 35 U. S. C. 142 in not setting forth their position as to the board's disposition of these dates in their reasons of appeal" (Pet. 8(a)).

This opinion of Judge Martin should be compared with his opinion in *Application of Arnold and Brandt*, 315 F. 2d 951, where he found the identical reasons of appeal sufficient since the examiner and the Patent Office Board of Appeals had relied on only one reference in rejecting the applicant's claims. Judge Martin's theory appears to be that reasons of appeal such as those given by petitioners in the instant case are sufficient where only one point is at issue, but are insufficient where multiple questions are involved. This being the case, the decision below is clearly in error because there was, in fact, only one point at issue. As pointed out by respondent in his brief (Res. 8):

> "The contested issue before the Patent Office was whether the German invention was patented on January 23, 1958, when a notice in the Patent blatt (Patent Gazette) announced that a patent had been granted, or whether it was patented in Germany on April 11, 1958, when the specification of the patent was issued in printed form in Germany * * *."

The respondent states further (Res. 8):

> "In light of the issue before the Patent Office, it would seem that the petitioners' statement of reasons for appeal should have alleged that the Patent Office erred in ruling that their invention was patented in Germany on January 23, 1958, instead of on April 11, 1958, and that, therefore, their application in this country was not barred by 35 U. S. C. 102(d)."

The above statements of the respondent clearly reveal that there was only one point at issue in the Patent Office

Board of Appeals, namely, hether the German patent was granted on January 23, 1958, or on April 11, 1958. If this fact had been realized by the concurring judge below, the decision of the Court of Customs and Patent Appeals would have been three to two in favor of the petitioners. The decision below thus is based upon a misinterpretation of fact by the judge whose concurring vote was determinative of the decision of the Court of Customs and Patent Appeals.

2. In the respondent's brief it is argued that a bill is pending before the House Committee on the Judiciary which would amend Sections 142, 143 and 144 of 35 USC for the purpose of conforming the procedures in patent appeals to the Court of Customs and Patent Appeals to those governing appeals from the district courts to the courts of appeals. It is argued that this is ". . . another factor militating against certiorari in this case" (Res. 9). No authority is cited to support respondent's argument that the pendency of legislation designed to change a law should prevent this Court from accepting a Petition for a Writ of Certiorari in a case which has been decided based upon a seemingly incorrect interpretation of such law.

Respectfully submitted,

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